



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

CAMPBELL, K.H.S.

Appl. No. 09/600,130

§ 371 Date: May 14, 2001

For: **Double Nuclear Transfer Method
and Results Thereof**

Confirmation No. 8898

Art Unit: 1632

Examiner: Woitach, J.

Atty. Docket: 1966.0010001/EKS/BJD/FRC

TECH CENTER 1600/2900

DEC 05 2002

RECEIVED
12/14/02

Reply To Restriction Requirement

Commissioner for Patents
Washington, D.C. 20231

Sir:

In reply to the Office Action dated **October 3, 2002** (PTO Prosecution File Wrapper Paper No. 9), requesting an election of one invention to prosecute in the above-referenced patent application, Applicant hereby provisionally elects to prosecute the invention of **Group I**, represented by claims 42-68, 73, 77, 80, 81 and 82. This election is made without prejudice to or disclaimer of the other claims or inventions disclosed.

This election is made **with** traverse.

The basis for the restriction requirement is the Examiner's assertion that "[t]he method of producing a reconstituted embryo by passing the nuclear donor through more than one recipient oocyte" is disclosed in U.S. Patent No. 5,942,435 to Wheeler (hereinafter "Wheeler"). See Paper No. 9, page 4. Applicant respectfully disagrees with this assertion.

The Examiner appears to have misunderstood the teachings of Wheeler and has erroneously concluded that Wheeler discloses a method encompassed by claim 42. In particular, the Examiner stated, "[i]n the detailed teaching for culturing and maintaining the embryonic stem cell, it is taught that the stem cell can be serially passaged by nuclear

transfer into an oocyte using nuclear transfer technology (column 11; lines 30-40)." Paper No. 9, page 4. The method of claim 42, however, comprises transferring a donor nucleus into a first recipient oocyte followed by removing and transferring the nucleus from the first recipient oocyte to a further recipient oocyte or an enucleated fertilized zygote. The section of Wheeler cited by the Examiner does not describe any of the elements of claim 42.

The portion of Wheeler cited by the Examiner simply describes a step in the process of purifying undifferentiated porcine embryonic stem (ES) cells. *See* Wheeler at column 10, lines 30-31. Wheeler states that cells are "passed" every 2-4 days in a medium called CSCM. *See id.* at column 11, lines 30-32. There is no mention of nuclear transfer or even the use of an oocyte. There is certainly no discussion in Wheeler of transferring a donor nucleus into a first oocyte followed by removing and transferring the nucleus from the first recipient oocyte to a further oocyte or an enucleated fertilized zygote.

Wheeler does indicate that isolated ES cell lines can subsequently be used for nuclear transfer. *See id.* at column 11, lines 36-37 and at column 18, lines 51-55. At best, however, Wheeler suggests only a *single* nuclear transfer. There is no mention or suggestion in Wheeler of *double* nuclear transfer as encompassed by claim 42. Thus, the method of claim 42 has *not* been previously disclosed in the art.

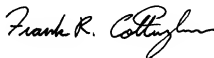
Accordingly, reconsideration and withdrawal of the Restriction Requirement, and consideration and allowance of all pending claims, are respectfully requested.

It is not believed that extensions of time are required, beyond those that may otherwise be provided for in accompanying documents. However, if additional extensions of time are necessary to prevent abandonment of this application, then such extensions of

time are hereby petitioned under 37 C.F.R. § 1.136(a), and any fees required therefor are hereby authorized to be charged to our Deposit Account No. 19-0036.

Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.



Frank R. Cottingham
Attorney for Applicant
Registration No. 50,437

Date: 12/02/02

1100 New York Avenue, N.W.
Suite 600
Washington, D.C. 20005-3934
(202) 371-2600



**Sterne Kessler
Goldstein Fox**
ATTORNEYS AT LAW



Robert Greene Sterne
Edward J. Kessler
James A. Goldstein
David K.S. Cornwell
Robert W. Leonard
Tracy-Gene G. Durkin
Michelle A. Cimbal
Michael B. Ray
Robert E. Sokol
Eric K. Stoffe
Michael G. Lee
Steven R. Lucking
John M. Cowert
Linda E. Alcom
Robert C. Millong
Lawrence B. Bigalsky
Donald J. Featherstone
Michael V. Messinger

Judith U. Kim
Timothy J. Shea, Jr.
Patrick S. Garrett
Jeffrey T. Healey
David L. Kass
Crystal D. Sayles
Edward W. Yee
Albert L. Terro
Donald R. Baranoff
Peter A. Judman
Molly A. McCall
Terena U. Medler
Jeffrey S. Weaver
Kendrick P. Patterson
Vincent L. Capasuto
Albert J. Russo II
Eldora Ellison Floyd
W. Russell Swindell

Thomas C. Fiala
Brian J. Del Buono
Vinyl Lee Braxton
Reginald D. Lucas
Elizabeth N. Reddick
Theodore A. Wood
Elizabeth J. Hawkins
Bruce E. Chaffler
Joseph S. Dagoff
Frank R. Cottingham
Christine M. Dullier
Rae Lynn Pienkman
Jane Shershtanzovich
Lawrence J. Carroll
George S. Bandmesser
Daniel A. Kian
Rodney G. Mize
Jason D. Eisenberg
Michael A. Specht

Registered Patent Agents*
Karen R. Markowitz
Andrea J. Karmage
Nancy J. Leith
Amy E. Summerfield
Helen C. Carlson
Gaby L. Longworth
Matthew J. Dowd
Aaron L. Schwartz
Angeline G. Uy
Boris A. Malventro
Mary B. Tung
Karlina Y. Pei
Bryan L. Skehon
Robert A. Schwartzman
John J. Figueroa
Timothy A. Doyle
Jennifer R. Mahalingappa

Senior Counsel
Samuel L. For
Kenneth C. Bass III
Lisa A. Dunner

*Admitted only in Maryland
*Admitted only in Virginia
*Admitted only in Texas
*Practice limited to
Federal Agencies

December 2, 2002

RECEIVED

WRITER'S DIRECT NUMBER:
(202) 371-2615

DEC 05 2002

INTERNET ADDRESS:
FRANKC@SKGF.COM

TECH CENTER 1600/2900

Art Unit 1632

Commissioner for Patents
Washington, D.C. 20231

Re: U.S. Utility Patent Application
Appl. No. 09/600,130; § 371 Date: May 14, 2001
For: **Double Nuclear Transfer Method and Results Thereof**
Inventor: Campbell, K.H.S.
Our Ref: 1966.0010001/EKS/BJD/FRC

Sir:

Transmitted herewith for appropriate action are the following documents:

1. Fee Transmittal Form (PTO/SB/17);
2. Petition for Extension of Time Under 37 C.F.R. § 1.136(a)(1);
3. Reply to Restriction Requirement;
4. Form PTO-2038 Credit Card Payment Form in the amount of \$110.00 to cover the extension of time fee; and
5. Return postcard.

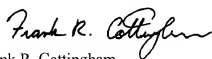
It is respectfully requested that the attached postcard be stamped with the date of filing of these documents, and that it be returned to our courier. In the event that extensions of time are necessary to prevent abandonment of this patent application, then such extensions of time are hereby petitioned.

Commissioner for Patents
December 2, 2002
Page 2

The U.S. Patent and Trademark Office is hereby authorized to charge any fee deficiency, or credit any overpayment, to our Deposit Account No. 19-0036.

Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.



Frank R. Cottingham
Attorney for Applicants
Registration No. 50,437

FRC/pcd
Enclosures

..ODMA\MHODMA\SKGF_DC1.80181;1

FEE TRANSMITTAL for FY 2003

Patent fees are subject to annual revision.

☐ Applicant claims small entity status. See 37 CFR 1.27

TOTAL AMOUNT OF PAYMENT (\$)**110.00**

Complete if Known

Application Number 09/060,130
\$ 371 Date May 14, 2001
First Named Inventor Campbell, K.H.S.
Examiner Name Weitsch, J.
Group Art Unit 1632
Attorney Docket No. 1966.0010001/EKS/BJD/FR

RECEIVED
DEC 05 2002

TECH CENTER 1600/2900

METHOD OF PAYMENT (check all that apply)

☐ Check ☒ Credit card ☐ Money Order ☒ Other** ☐ None

☐ Deposit Account
Deposit Account Number 19-0036

Deposit Account Name: Sterne, Kessler, Goldstein & Fox P.L.L.C.

The Commissioner is authorized to: (check all that apply)

☒ Charge fee(s) indicated below ☒ Credit any over payments

☒ Charge any additional fee(s) during the pendency of this application

☐ Charge fee(s) indicated below, except for the filing fee to the above-identified deposit account.

** Charge any deficiencies or credit any overpayments in the fees or fee calculations of Parts 1, 2 and 3 below to Deposit Account No. 19-0036

FEE CALCULATION

1. BASIC FILING FEE

Large Entity Small Entity

Fee Code	Fee (\$)	Fee Code	Fee (\$)	Fee Description	Fee Paid
1001	740	2001	370	Utility filing fee	
1002	330	2002	165	Design filing fee	
1003	510	2003	255	Plant filing fee	
1004	740	2004	370	Reissue filing fee	
1105	160	2005	80	Provisional filing fee	

SUBTOTAL (1) (\$)

2. EXTRA CLAIM FEES FOR UTILITY AND REISSUE

Total Claims	Extra Claims	Fee from below	Fee Paid
Independent Claims - 20** =	x		
Multiple Claims - 3** =	x		
Dependent			

Large Entity Small Entity

Fee Code	Fee (\$)	Fee Code	Fee (\$)	Fee Description
1202	18	2202	9	Claims in excess of 20
1201	84	2201	42	Independent claims in excess of 3
1203	280	2203	140	Multiple dependent claim, if not paid
1204	84	2204	42	**Reissue independent claims over original patent
1205	18	2205	9	**Reissue claims in excess of 20 and over original patent

SUBTOTAL (2) (\$)

**or number previously paid, if greater; For Reissue, see above

FEE CALCULATION (continued)

3. ADDITIONAL FEES

Large Entity Small Entity

Fee Code	Fee (\$)	Fee Code	Fee (\$)	Fee Description	Fee Paid
1051	130	2051	65	Surcharge - late filing fee or oath	
1502	50	2052	25	Surcharge-late provisional filing fee or cover sheet	
1053	130	1053	130	Non-English specification	
1812	2,520	1812	2,520	For filing a request for ex parte reexamination	
1804	920*	1804	920*	Requesting publication of SIR prior to Examiner action	
1805	1,840*	1805	1,840*	Requesting publication of SIR after Examiner action	
1251	110	2251	55	Extension for reply within first month	110.00
1252	400	2252	200	Extension for reply within second month	
1253	920	2253	460	Extension for reply within third month	
1254	1,440	2254	720	Extension for reply within fourth month	
1255	1,960	2255	980	Extension for reply within fifth month	
1401	320	2401	160	Notice of Appeal	
1402	320	2402	160	Filing a brief in support of an appeal	
1403	280	2403	140	Request for oral hearing	
1451	1,510	1451	1,510	Petition to institute a public use proceeding	
1452	110	2452	55	Petition to revive - unavoidable	
1453	1,280	2453	640	Petition to revive - unintentional	
1501	1,280	2501	640	Utility issue fee (or reissue)	
1502	460	2502	230	Design issue fee	
1503	620	2503	310	Plant issue fee	
1460	130	1460	130	Petitions to the Commissioner	
1807	50	1807	50	Processing fee under 37 CFR 1.17(a)	
1806	180	1806	180	Submission of Information Disclosure Stmt	
8021	40	8021	40	Recording each patent assignment per property (times number of properties)	
1809	740	2809	370	Filing a submission after final rejection (37 CFR 1.129(a))	
1810	740	2810	370	For each additional invention to be examined (37 CFR 1.129(b))	
1801	740	2801	370	Request for Continued Examination (RCE)	
1802	900	1802	900	Request for expedited examination of a design application	

Other fee (specify)

* Reduced by Basic Filing Fee Paid

SUBTOTAL (3) (\$)**110.00**

SUBMITTED BY

Name (Print/Type)	Registration No. (Attorney/Agent)	Telephone	Complete (if applicable)
Frank R. Cottingham	50,437	202-371-2600	
Signature	<i>Frank R. Cottingham</i>	Date	12/02/02

WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit information and authorization on PTO-0038.

This collection of information is required by 37 CFR 1.17 and 1.27. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing the burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, Washington, DC 20231. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, Washington, DC 20231. If you need assistance in completing the form, call 1-800-PTO-9199 (1-800-786-9199) and select option 2. ext. 201.